



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 10/10/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/319,438

Applicant(s)

WALTERS ET AL.

Examiner

Christopher C. Pratt

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2000.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☒ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☒ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims are so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood:

Claims 1-2 and 6 are indefinite because they recite the phrase "a substance (weight/unit area)." It is not possible to determine what applicant is referring to with this phrase. There is no definition within applicant's specification of this term. Furthermore any phrase contained within parenthesis is not given patentable weight.

Claims 1-2 and 6 are also indefinite because they recite the phrase "edge margins." There is no definition within applicant's specification to indicate what the dimension of an edge "margin" would be.

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Claims 1-2 and 6 are indefinite because they refer to a substance which "varies" in the cross direction. How does this substance vary? Does the composition of the substance change or does the amount of the substance change?

Claims 2-9 are also indefinite because they refer to a forming wire being "masked" by a "blinding plate." What is a "blinding plate" and how does applicant intend to use it to "mask" a forming wire? By "mask" does applicant mean cover part of a forming wire? Claim 4 suggests that both the forming wire and "blinding plate" move independently of each other. Is this the case or is the "blinding plate" somehow attached to the forming wire? Neither of these terms are defined in the specification.

Claim 4 is indefinite because it recites the term "remote." Does applicant mean "away from?"

Claim 5 is indefinite because it recites the phrase "effective width." There is no definition of this term within applicant's specification. How is the "effective width" different from the width?

With respect to claim 6 the phrase "a forming wire disposed to...on the forming wire" is confusing and awkward. This phrase should be changed to more clearly point out applicant's invention.

Claims 6 and 7 refer to the "effectiveness of the mask." What does this phrase mean? How is the mask more or less "effective?"

Claim 7 recites the preamble limitation "apparatus" while depending from claim 3, which is drawn to a method. Did applicant intend for claim 7 to depend from claim 3?

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Claim 8 is indefinite because it recites the term "impinging." This term is extremely broad. How does the "blinding plate" "impinge" the "forming wire." Claim 8 is also indefinite because it refers to a wire having a "face." Where is the "face" of a wire located?

Claims 10-11 are indefinite because they recite the phrase "cementitious." What is the intended meaning of this word? Is applicant attempting to refer to a board comprising cement?

Claims 10-11 are also indefinite because the spatial relationship of applicant's invention can not be determined. How is the mat "embedded" below a surface of a board?

Claim 11 is indefinite because it refers to the permeability of a mat to cementitious slurry that varies. How does the permeability vary?

4. Applicant is required to submit an amendment, which clarifies the claimed invention so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Timms (4415517).

Timms patent is concerned with the creation of an inorganic fiber mat having a substance which varies in the cross direction. The ends of said mat being of lower substance than the rest of the mat (fig. 5). The term "substance" is indefinite, as set forth above, however the examiner interprets this term to mean the width of the material.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajander (5462642).

Kajander's patent is concerned with the creation of an inorganic fiber mat. Kajander teaches masking a forming wire in preselected areas with "any suitable

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means" including coatings and pattern printings to create a mat having areas of less substance (summary of the invention). As a result of the 112 problems it is the examiners position that Kajander's coatings and pattern printings are equivalent to applicant's "blinding plate." Kajander doesn't seem to disclose specifically masking the edges of a mat, however he does disclose masking any possible pattern of the forming wire. Therefore it would have been obvious to a person of ordinary skill in the art to mask the edge regions as an obvious matter of design choice.

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajander (5462642) in view of Prior et al (4141744) and JP-3120013.

Kajander discloses all elements of applicant's claims 3 as set forth above.

Kajander does not seem to disclose the use of cement.

Both Prior and JP-3120013 are concerned with the creation of a board comprising cement with a nonwoven web embedded therein. It would have been obvious to a person of ordinary skill in the art to embed the web of Kajander in cement as taught by Prior and JP-3120013. Such a combination would have been motivated by the reasoned expectation of increasing the strength of the web.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

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If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt  
October 6, 2000

*Elizabeth M. Cole*  
ELIZABETH M. COLE  
PRIMARY EXAMINER